



1772

Attorney Docket No. 10113

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
Gloyer et al.)

Serial No.: 09/802,760)
Filed: March 8, 2001)

Examiner: P. Nordmeyer)
Art Unit: 1772)

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For: POLYURETHANE ELASTOMERS AND SHAPED ARTICLES PREPARED THEREFROM

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RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Office Action (Paper No. 9) mailed August 16, 2002, Applicants elect the claims of Group I with traverse.

In the Office Action, the currently pending claims (Claims 1-48) are divided into four groups as follows:

I. Claims 1-9, 25-32, and 47, drawn to a polyurethane elastomer, classified in class 528.

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II. Claims 15-24, 38-46, and 48, drawn to a shaped article, classified in class 428, subclass 36.91.

III. Claims 10 and 33, drawn to a shaped article, classified in class 428, subclass 36.91.

IV. Claims 11-14 and 34-37, drawn to a transfer roller, classified in class 399, subclass 101.

The Office argues that Groups I and II are related as mutually exclusive species in an intermediate-final product relationship. It is argued that distinctness is proven if the intermediate product is useful to make other than the final product, citing MPEP § 806.04(b), 3rd paragraph and MPEP § 806.04(h). It is asserted that the intermediate product is deemed to be useful as a coating on an electronic composite and that the inventions are deemed patentably distinct since there is nothing on the record to show them to be obvious variants.

Similarly, the Office argues that Groups I and III, and also Groups I and IV, are each distinct for the same reason.

Relying on the foregoing reasoning, the Office concludes that the four groups are distinct, each from the other.

While the Office Action details reasons why Group I is deemed to be distinct from each of Groups II, III and IV respectively, there is no reasoning expressed as to why Groups II, III and IV are distinct from each other. Under § 803 of the MPEP, it is said:

"Under the statute an application may properly be required to be restricted to one of two or more

claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04-806.04(i)) or distinct (MPEP § 806.05-806.05(i)).

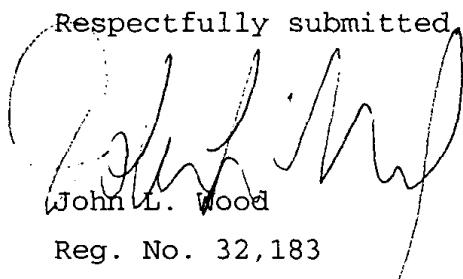
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

Here Groups II, III and IV all concern articles, such as a transfer roller. It is submitted that a separate search as to each of these groups of claims is unnecessary. In particular, Applicants note that Groups II and III are both classified by the Office in class 428, subclass 36.91. Accordingly, it is respectfully submitted that there would be no serious burden if restriction were not required, and that all of the claims in Groups II, III and IV should be examined together. Applicants respectfully traverse the restriction requirement on this basis.

In addition, the Office Action indicates that Group II, Claims 15-24, 38-46, and 48, is subject to a species election, if the invention of Group II is elected. While Applicants are not electing Group II in response to the restriction requirement, Applicants note that the requirement for a species election in connection therewith appears to be improper. In this regard, on page 5 of the Office Action, the species asserted to be included in Group II are listed. The asserted species are all described as hardeners comprising at least one additional polyol and at least one charge-control agent with a functionality of 0.96 to 1.04, or in a narrower range within 1.00 to 1.04 that is within the broader range. In the Specification, at page 17, line 20 and thereafter, it

is indicated that the hardener mixture reacts with prepolymer. Accordingly, it appears that the election requirement is improper.

Applicants respectfully request reconsideration of the restriction and election requirements.

Respectfully submitted

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Dated: August 28, 2002